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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/424,300	03/13/2000	YOSHIKAZU KANEKO	Q56361	7799

7590 02/11/2003

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WASHINGTON, DC 200373213

EXAMINER

PIZIALI, ANDREW T

ART UNIT	PAPER NUMBER
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1775

17

DATE MAILED: 02/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

AS17

Office Action Summary

Application No.

09/424,300

Applicant(s)

KANEKO ET AL.

Examiner

Andrew T Piziali

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 December 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 5-12 is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau. (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- ☐ Interview Summary (PTO-413) Paper No(s). _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-4 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 5,888,321 to Kazama.

Kazama discloses a steel wire having a diameter ranging from 0.1 to 0.4 mm (column 6, lines 20-33) obtained by subjecting a high-carbon steel wire material having a carbon content ranging from 0.80 to 0.89 in weight to heat treatment and wire drawing (column 3, lines 35-50). Kazama discloses that the upper limit of the tensile strength of the steel wire satisfies the formula $TS \geq -1960D + 4214$ (column 4, lines 35-40) where TS is the tensile strength in N/mm^2 and D is the diameter of the steel wire in mm. When $D=0.3mm$ formula $TS \geq -1960D + 4214$ results in a $TS \geq 3626 N/mm^2$, formula $TS \geq 2250-1450\log D$ results in a $TS \geq 3008 N/mm^2$, and formula $TS \geq$

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2750-1450logD results in a $TS \geq 3508 \text{ N/mm}^2$. Kazama satisfies the formula $TS \geq 2250-1450\log D$ and the formula $TS \geq 2750-1450\log D$ when $D=0.3\text{mm}$.

Kazama uses drawing dies ranging from 8-10 degrees with a bearing length of 0.3D (column 4, lines 6-18). Kazama also uses a final die area reduction of 1.2 to 3.9 % and immediately after passing through the final die the steel wire temperature is maintained below 150°C (column 4, lines 6-18). Kazama uses a torsion test in which tension is lightly applied while the steel wire is twisted in one direction and then twisted in the reverse direction (column 7, lines 43-58). Kazama discloses that the steel wire possess not only a high tensile strength but also a high toughness along with good twisting efficiency and good fatigue resistance (column 4, lines 53-61). Kazama does not mention a breaking torsion value or a repeated torsion value, with or without 10% of the total volume removed from the surface, however, due to the substantially identical steel wire composition and manufacturing method The Patent and Trademark Office can require applicants to prove that prior art products do not necessarily or inherently possess characteristics of claimed products where claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes; burden of proof is on applicants where rejection based on inherency under 35 U.S.C. § 102 or on prima facie obviousness under 35 U.S.C. § 103, jointly or alternatively, and Patent and Trademark Office's inability to manufacture products or to obtain and compare prior art products evidences fairness of this rejection, *In re Best, Bolton, and Shaw*, 195 USPQ 431 (CCPA 1977).

Kazama does not specifically mention preforming the steel wire to a minimum radius of curvature of 10 to 60 times its diameter, but the reference fails to suggest that the radius of curvature to diameter ratio is outside the range of 10 to 60. Absent a showing of otherwise, the

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steel cord of Kazama appears to have a radius of curvature to diameter ratio in the range of 10 to 60.

Response to Arguments

3. Applicant's arguments filed 12/18/2002 have been fully considered but they are not persuasive. The applicant asserts that the amendment of claim 1, filed 12/18/2002, removes the applied prior art rejection. The examiner respectfully disagrees.

The amendment consisted of adding the intended use "for cords having a construction of core and sheath." In response to applicant's argument that amendment of claim 1 filed 12/18/2002 removes the applied prior art rejection, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Allowable Subject Matter

4. Claims 5-12 are allowed.

5. The following is an examiner's statement of reasons for allowance:

Japanese Patent No. 7-305285 to Takayuki is the best art disclosing a method of manufacturing a high-carbon steel wire with a diameter of 0.2 to 0.6mm with heat treatment and characterized in that the step of drawing is carried out according to steps 1-3 and 5 of applicants disclosure in claim 5. Takayuki also discloses the strain at the final die to be 4.0. It would not

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have been obvious to one having ordinary skill in the art at the time the invention was made to use a reduction per die set from 4% to $(-8.3\epsilon + 40.6)$ for the final die or to thereafter use a bending operation with tension applied to the steel wire drawn through the final die.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew T Piziali whose telephone number is (703) 306-0145. The examiner can normally be reached on Monday-Friday (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones can be reached on (703) 308-3822. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-5665.

g-13

atp

January 28, 2003

Andrew T Piziali

Examiner

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Deborah Jones

DEBORAH JONES
SUPERVISORY PATENT EXAMINER